

**REMARKS**

Claims 15-16 and 20-29 are pending.

Claims 15-16 and 20-29 stand rejected.

Claims 15-16 and 20-29 are hereby submitted for review and consideration.

No new matter has been added.

Applicant notes that claims 15-16 and 20-29 as presented herein have not been altered, and presented herein as amended in the previous Amendment of January 29, 2003, for the Examiner's convenience.

In the Office Action, the Examiner has rejected claims 15-16, 20-21 and 26-29 under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner cites as examples, in independent claim 15, "downwardly against said first side wall," and in independent claim 26, "lower portion is disposed along said first sidewall, parallel to both edges of the plane of said first sidewall. The Examiner further contends that Figures 9A and 9B merely shows broken lines that "indicate a straw is broadly located inside the container.," and that, "[T]he specific orientation of the lower portion of the straw as claimed in not shown.

Applicants respectfully disagree with the Examiner's contentions and submit the following remarks in response.

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In independent claim 15, a straw is claimed in conjunction with a container, where the straw is claimed as an extendable straw, having upper and lower portions, where *the lower portion extends downwardly against said first side wall*. Applicant submits that this element is in fact supported in the specification as filed.

As discussed in the previously filed Amendment, The relevant portions of the application that support the elements of claim 15 are found in Figs. 9A and 9B as well as lines 19-23 of page 10 of the specification.

Specifically, the lower portion of the straw, extending downwardly along the first side wall of the container, is adequately supported in the specification by the drawings in Figs. 9A and 9B which clearly illustrate this arrangement. It is evident from Figs. 9A and 9B that that lower portion of the straw is clearly shown to *extend downwardly along the side wall*.

However, the Examiner contends that because the figures show the lower portion of the straw is shown in “interrupted lines,” they are intended to merely broadly convey location within the container, rather than illustrate a specific location along the first side wall. Such an interpretation by the Examiner however, is not in accordance with a standard interpretation of these figures by one of ordinary skill in the art. Those familiar with technical drawings in this field, and of ordinary skill in the art, readily associate the drawings of lower portion of the straw in dashed lines in Figs. 9A and 9B to indicate that the straw extends downwardly against the first side wall, but that it is simply not visible from the outside of the container.

In support of this contention, Applicant hereby submits Declarations from three independent individuals, of ordinary skill in the art, who have reviewed Figs. 9A and 9B

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and have indicated that the relevant drawings unambiguously indicate that the lower portion of the straw does in fact *extend downwardly along the side wall*.

A first Declaration under 37 CFR 1.132, submitted herewith as Appendix I, is by Dr. Sidi Berri, a mechanical engineering professor. A second Declaration under 37 CFR 1.132, submitted herewith as Appendix II, is by Mr. Jacob Cohen, an owner of a plastic straw manufacturing company. A third Declaration under 37 CFR 1.132, submitted herewith as Appendix III, is by Mr. Daniel Kamel, an architectural designer.

In each of the three cases, the Declarants, all of ordinary skill in the art, have indicated, that Figs. 9A and 9B of the application clearly show that the straw is attached to the inner first side wall of the container. Their assertions rest on their knowledge and experience with technical drawings. They note that their conclusions were reached because the dotted lines, depicting the straw, extends in parallel with both sides of the surface of the wall the straw extends along, and do not exhibit any ambiguity. They each have independently concluded that the figures clearly illustrate a straw that extends against the first side wall of the container.

Furthermore, the Declarants go on to state that their conclusions, about Figs. 9A and 9B, are even more apparent from Figs. 8A and 8B, where the straw is depicted as a straw, floating within the container using the same dashed lines. They note that in contrast with Figs 9A and 9B, the dotted lines representing the straw are not parallel with any of the sides of the surface of the walls of the container. Thus, they conclude that Figs. 8A and 8B show that the straw is floating, whereas Figs. 9A and 9B show that the straw is along the first side wall.

As discussed in the prior Amendment, Applicant notes that the Court of Appeals

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for the Federal Circuit has recognized that, “drawings alone may provide a ‘written description’ of an invention as required by §112.” *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ 2d 1111, 1117 (Fed. Cir. 1991); *See also In re Heinle*, 145 USPQ 131 (CCPA 1965) (Where the court stated that it is proper to include matter that is clearly and conclusively disclosed by the drawings. Were the drawings appear to conform to the one-fourth circumference limitation, it is possible to amend the application to include the one-fourth limitation without violating the rule against “new matter”.)

Also, in *Vas-Cath, Inc.*, the judges specifically relied on evidence presented in a Declaration confirming that the drawings did in fact convey to one of ordinary skill in the art the necessary support for the claimed language. In further support of their decision, the Court cited to the lack of any evidence, to indicate how one of ordinary skill in the art could interpret the drawings to the contrary of that presented in the Declaration. *See Id at 1566-1567.*

In addition, as discussed in the previous Amendment, in the specification on page 11 and as shown in Fig. 10C, a pouch is, “sealed to the inside of container 70” and, “a ripple 92 in pouch 66 forms a straw that can be accessed through scored finger 60.” It is evident that this straw is attached to the side wall by virtue of it being formed from a pouch that is sealed to the side wall. In Fig. 10C the lower portion of the straw is illustrated as extending downwardly along the side wall, parallel to the plane of and the edges of the side wall. As such, it is consistent throughout the specification and figures 9A, 9B and 10C and in the accompanying specification to support the claims of the present application.

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As such, Applicant respectfully submits that Figs. 9A and 9B, as filed provide sufficient support in the specification, for the element of claim 15 where the lower portion of the straw extends downwardly along the side wall. Further, Applicant has submitted three independent declarations from individuals of ordinary skill in the art confirming such a conclusion. Thus, Applicant submits that the Examiner's interpretation of the interrupted lines of Figs. 9A and 9B is in error. And, absent any showing in opposition to the submitted Declarations, Applicant requests that the rejection of claim 15, and the claims that depend therefrom, under 35 U.S.C. § 112, be withdrawn.

Turning now to independent claim 26, the Applicant has claimed a straw in conjunction with a container where lower portion is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall.

As discussed above, Applicant notes that Figs. 9A and 9B clearly show such an arrangement. Furthermore, the three independent Declarations each states that the dotted lines, depicting the straw, are extended in parallel with both sides of the surface of the wall the straw extends along.

Thus, for the same reasons as stated above, Applicant respectfully submits that Figs. 9A and 9B, as filed provide sufficient support in the specification, for the element of claim 26 where the lower portion of the straw is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall. Further, Applicant has submitted three independent declarations from individuals of ordinary skill in the art confirming such a conclusion. Thus, Applicant submits that the Examiner's interpretation of the interrupted lines of Figs. 9A and 9B is in error. And, absent any showing in opposition to the submitted declarations, Applicant requests that the rejection

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of claim 26, and the claims that depend therefrom, under 35 U.S.C. § 112, be withdrawn.

Turning now to the rejections in view of the prior art, the Examiner has rejected claims 15, 16 and 20-29 under 35 U.S.C. § 102(b) as being anticipated by any one of Wen (U.S. Patent No. 5,482,202), or Cornell (U.S. Patent No. 6,076,729).

Applicant respectfully disagrees with the Examiner's contentions and submits the following remarks in response.

The present invention is directed to a cap assembly comprising a container and a straw. As claimed in independent claim 15, the lower portion of the straw extends downwardly along the side wall. As claimed in independent claim 22, the upper portion, and the lower portion of the straw are connected by pleats, such that the pleats are required to allow an unimpeded flow of liquid that passes through said straw. As claimed in independent claim 26, the lower portion of the straw is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall, and extends downwardly along the side wall.

In this configuration the present invention allows a user to tilt the container towards themselves in a comfortable natural position assured that the straw will be located at the bottom of the container relative to the fluid contained therein, without twisting the container in any uncomfortable configurations.

Additionally, the present invention maintains a flexible portion which prevents the bent straw from kinking within the closed container even though the straw is against a single first side of the container. Furthermore, by arranging the top opening of the straw in a fixed co-planar arrangement with the top side of the scored finger portion cap, the user can easily close the container without having to awkwardly maneuver the straw.

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Also the user is assured that when re-opened, the straw will be easily accessible on the underside of the scored finger portion cap.

On the contrary, the cited prior art does not teach such an arrangement for a lower portion of a straw.

The cited prior art, namely Wen, is directed to a drink box with a built in straw. In Wen, a straw is attached to the inside of drink container, with a lower portion attached to one side of the container and an upper portion attached to a triangular disposable section located at the *opposite* side of the container, such that the triangular portion of the container can be removed pulling the upper portion of the straw out of the container for drinking. The triangular portion is then discarded.

The cited prior art, namely Cornell, is directed to fluid dispensing spout for beverage containers. Cornell is directed to straw disposed within a container, configured to be exposed when a cap portion is opened. In the various embodiments, the straw is freely contained at lower end within the container and the upper end is attached or directed towards a cap region. When the cap is opened, the straw is exposed, unattached to the cap, beyond the top of the cap for the user to drink from.

Contrary to the Examiner's contention, there is no teaching or suggestion in any of the cited prior art, either alone or in combination with one another, which teaches or suggests the present invention as claimed. It is evident that the Cornell reference makes no showing of a lower portion of straw posited along a side wall. Furthermore, the Wen reference only shows attachment of the lower portion of the straw to the *opposite* side of the container. Such arrangements do not confer the advantages of the present invention discussed above.

As the cited prior art does not teach or suggest the present invention as claimed in the independent claim 15. For example, there is no teaching or suggestion in either Wen or Cornell that discloses a lower portion of straw extending downwardly along a first sidewall. Dependent claims 16, 20 and 21, which depend therefrom, are allowable for the same reason.

Likewise, the cited prior art does not teach or suggest the present invention as claimed in the independent claim 22. For example, there is no teaching or suggestion in either Wen or Cornell that discloses an upper portion lower portion of a straw connected by pleats, *such that the pleats are required* to allow an unimpeded flow of liquid that passes through said straw. In Wen the pleats are not required for unimpeded flow between the upper and lower portions of the straw because the lower portion is attached to the opposite side of the container. In Cornell the pleats are unnecessary because the lower portion of the straw is free to move about the inside of the container. Dependent claims 23-25, which depend therefrom, are allowable for the same reason.

Furthermore, the cited prior art does not teach or suggest the present invention as claimed in the independent claim 26. For example, there is no teaching or suggestion in either Wen or Cornell that discloses a lower portion of a straw disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall. Dependent claims 27-29, which depend therefrom, are allowable for the same reason.

As such, Applicant requests that the rejection of claims 15-16, 20-21 and 26-29 under 35 U.S.C. § 112 and the rejections of claims 15-16 and 20-29 under 35 U.S.C. § 102(b) be withdrawn. Thus, it is respectfully submitted that the present invention as claimed is now in condition for allowance, the earliest possible notice of which is

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earnestly solicited. If the Examiner feels that a telephone interview would advance the prosecution of this application he is invited to contact the undersigned at the number listed below.

Respectfully submitted

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By:

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